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OFFICE OF PETITIONS

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In re Application of :
Israeli et al. :
Application No. 08/470,735 : **DECISION ON PETITION**
Filed: June 6, 1995 :
Attorney Docket No. 41426-D/JPW/BJA :

This is a decision on the petition filed July 5, 2006, requesting (1) reconsideration of the dismissal mailed May 3, 2006, of the previous petition under 37 CFR 1.313(a) filed July 30, 2004, to withdraw the above-identified application from issue, which is properly treated as a petition under 37 CFR 1.313(c), or in the alternative, (2) under 37 CFR 1.183, waiver of the rules with the same result.

The petition considered under 37 CFR 1.313(a), or 1.313(c), is **DISMISSED**.

The petition considered under 37 CFR 1.183 is **DISMISSED**.

The Technology Center Group Director dismissed the requested withdrawal in the decision of May 2, 2006. The decision correctly noted that petitioner's lack of supplying the statement required by 37 CFR 1.97(e)(1) or (e)(2) such the examiner lacked any authority to consider the IDS was not good and sufficient reasons for withdrawal and that petitioner had not supplied any other adequate basis for withdrawal.

Petitioner again asserts that withdrawal of this application from issue is warranted such that the IDS filed July 23, 2004, and thereafter may be considered by the examiner. In the alternative, waiver of the rules is requested. Both petitions are properly before the Office of Petitions.¹

As to the petition considered under 37 CFR 1.313(a):

Inspection of USPTO records reveals that applicant paid the issue fee on July 23, 2004. Accordingly, 37 CFR 1.313(a) no longer applies to this application, as that part of the regulation only speaks to petitions for withdrawal filed *prior* to payment of the issue fee. See MPEP 1308. The petition filed July 23, 2004 as it was filed prior to payment of the issue fee, was properly considered by the Group Director under the terms of 37 CFR 1.313(a). As such, the petition filed July 5, 2006, considered under 37 CFR 1.313(a), must be dismissed as immaterial. Note further that MPEP § 1308 gives as an example a reason that does not warrant withdrawing an application from issue after payment of the issue fee at the initiative of the Office: to permit the examiner to consider an information disclosure statement. Once the issue fee is paid, an applicant's request for withdrawal is permitted only for the reasons stated in 37 CFR 1.313(c), and petitioner has failed to meet any of the requirements of 37 CFR 1.313(c) for withdrawal after payment of the issue fee. See MPEP 1308.

With respect to the petition considered under 37 CFR 1.183:

The regulations pertaining to the submission of an information disclosure statement (IDS) do not

¹ As explained in MPEP 1002.02(b), ¶¶ 2, 33, only the Office of Petitions has the delegated authority to decide a petition under 37 CFR 1.313(c) or § 1.183.

require that an IDS be filed, but rather, set forth the circumstances and conditions under which the Office will consider information promptly brought to its attention by applicant(s). Further, these circumstances and conditions are linked to the stage of prosecution at the time of submission of the IDS, as it is necessary for the Patent and Trademark Office (Office) to balance its need and desire to consider all information relevant to an application with its need for an efficient operation and its capability to consider information at various stages in the prosecution of an application. The *quid pro quo* for USPTO consideration of an IDS after close of prosecution is, however, that applicant diligently present the information to the USPTO, a circumstance that did not happen here.

Here, it is due to the delay of applicants and their former registered practitioner, that the requisite statement under 37 CFR 1.97(e) cannot be made. It is thus clear that petitioner is attempting in the guise of a petition filed under 37 CFR 1.313(a), or waiver of the requirements of 37 CFR 1.131(a), to circumvent the requirements of 37 CFR 1.97(d).

In order for grant of any petition under 37 CFR 1.183, petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. *In re Sivertz*, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985). Petitioner has not shown that either condition exists in this case.

Petitioner asserts that the information in question, while such was first made known to petitioner upon the March 5, 2004 Office action from the Japanese Patent Office, went through several levels of consideration and review by domestic and foreign counsel and a licensee *vis a vis* its relevance to the instant application. However, the time for making the assertion required by 37 CFR 1.97(d) that would permit consideration of the information expired June 5, 2004.

While petitioner's candor is appreciated, nevertheless, the circumstances of this case do not demonstrate an extraordinary situation, much less one where justice requires waiver of the rules. Since this application had received an action closing prosecution--the Ex Parte Quayle action of October 22, 2002, which is long before applicant first became aware of the information--regardless of its relevance to this application--a certification has been continuously required since that time as a condition of having an IDS considered. See 37 CFR 1.97(d). The Notice of Allowance of April 20, 2004, did not alter or change the requirement for an assertion, or reset the three month period in which the IDS must be filed at the USPTO in order for it to be considered by the examiner. That is, petitioner, at the time he first became aware of the information, could have made the certification, and submitted the information, certification, petition, and fee to the Office, and as such, the information would have been considered by the Office.² Petitioner's, and petitioner's counsel's undue delay in taking appropriate action with respect to this application is not seen to warrant equitable tolling of the period set forth in 37 CFR 1.97(e). See, *Vincent v. Mossinghoff*, 230 USPQ 621, 625 (D.D.C. 1985).

It is well settled that a party's inadvertent failure to comply with the requirements of the rules or procedures before the USPTO is not deemed to be an extraordinary situation that would warrant waiver of the rules or procedures under 37 CFR 1.183. See *Honigsbaum v. Lehman*, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995) (Commissioner did not abuse his discretion in refusing to waive requirements of 37 CFR 1.10(c) in order to grant filing date to patent application, where applicant failed to produce "Express Mail" customer receipt or any other evidence that application was actually deposited with USPS as "Express Mail"), *aff'd without opinion*, 95 F.3d 1166 (Fed. Cir.1996); *Nitto Chemical Industry. Co., Ltd. v. Comer*, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (Commissioner's refusal to waive requirements of 37 CFR 1.10 in order to grant

² The preliminary "Notice of Proposed Rulemaking, Duty of Disclosure" 56 *Fed. Reg.* 37321 (Aug. 6, 1991) at 37326 emphasized that the time that the information was known to any individual designated in 37 CFR 1.55(c) is the time when the information was first discovered, even if applicant's awareness of the materiality came later. This encourages prompt evaluation of the relevance of information and to have a date certain for determining if a certification under 37 CFR 1.97(e) can be properly made. Likewise the 3 month period for submission of the IDS after discovery of the information is familiar to users of the patent system and based on the normal shortened statutory period for reply to an Office action. See "Notice of Final Rulemaking, Duty of Disclosure", 57 *Fed. Reg.* 2021, 2027-2028 (January 17, 1992).

priority filing date to patent application not arbitrary and capricious, because failure to comply with the requirements of 37 CFR 1.10 is an "avoidable" oversight that could have been prevented by the exercise of ordinary care or diligence, and thus not an extraordinary situation under 37 CFR 1.183); Gustafson v. Strange, 227 USPQ 174 (Comm'r Pats. 1985) (Counsel's unawareness of 37 CFR 1.8 not extraordinary situation warranting waiver of a rule). Rather, as the USPTO did not cause or contribute to the delay in consideration of the information, this is not an "extraordinary situation" where "justice requires" an extraordinary remedy. See Helfgott & Karras, P.C. v. Dickinson, 209 F.3d 1328, 54 USPQ2d 1425 (Fed. Cir. 2000).

Moreover, petitioner concededly has a suitable remedy on hand for his predicament, that does not require the extraordinary remedy of invoking 37 CFR 1.183. It is brought to petitioner's attention that the PTO will not normally consider an extraordinary remedy, when the rules already provide an avenue for obtaining the relief sought. See Cantello v. Rasmussen, 220 USPQ 664, 664 (Comm'r Pat. 1982). As set forth in MPEP § 609, applicants wishing to have the PTO consider an IDS, where, as apparently herein, the necessary certification cannot be made, should consider the filing of a continuing application under 37 CFR 1.53(b), wherein the applicants may bring the references to the attention of the examiner without having to also tender a certification. Since, as petitioner acknowledges he can file a continuing application, then petitioner is not unduly prejudiced by this decision. As to the term of any forthcoming continuing application, it is noted that the patent statute and regulations do not compel an applicant to claim benefit under 35 U.S.C. § 120 of any earlier application that might shorten the term of any forthcoming patent under 35 U.S.C. § 154. However, should petitioner claim the potential benefits of an earlier application(s) via 35 U.S.C. § 120 in a forthcoming continuing application, then petitioner must also accept the consequences attendant to that action. See Abbott Laboratories v. Novopharm Ltd., 38 USPQ2d 1309, 1312 (D.C. N. II. 1996), aff'd 104 F.3d 1305, 41 USPQ2d 1535 (Fed. Cir. 1997). Indeed, the possible loss of term if a continuing application is filed, should have been the impetus for the diligent filing of the IDS in question. While petitioner may be concerned about the loss of term should a continuing application be necessary to get the contested references considered, the underlying delay necessitating such an action is that of petitioner, not the USPTO. Petitioner may also seek relief under the provisions of 35 U.S.C. § 251 or § 302 and their promulgating regulations, and may also wish to consider 37 CFR 1.313(c)(1) or (c)(3).

This application is being referenced to the Office of Publications for issuance as a patent.

Any inquiries concerning this decision may be directed to the undersigned at (571) 272-3217.



Brian Hearn
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Office of Petitions